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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91195943
Party	Plaintiff Integrated Management Information, Inc.
Correspondence Address	CHERYL L BURBACH HOVEY WILLIAMS LLP 10801 MASTIN BOULEVARD SUITE 1000, 84 CORPORATE WOODS OVERLAND PARK, KS 66210 UNITED STATES clb@hoveywilliams.com, litigation@hoveywilliams.com
Submission	Rebuttal Brief
Filer's Name	Cheryl L. Burbach
Filer's e-mail	clb@hoveywilliams.com, litigation@hoveywilliams.com
Signature	/Cheryl L. Burbach/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Integrated Management Information, Inc.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91195943
)	
Frank Barrie)	
)	
Applicant.)	

OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS TRIAL BRIEF

Respectfully Submitted,

Cheryl L. Burbach
HOVEY WILLIAMS LLP
10801 Mastin Boulevard, Suite 1000
Overland Park, KS 66210
Phone: 913-647-9050
Fax: 913-647-9057
Email: clb@hoveywilliams.com

*Attorneys for Opposer
Integrated Management Information, Inc.*

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ARGUMENT

The parties' respective marks are nearly identical in appearance and sound, and convey the same commercial impression. Applicant posits that there is no likelihood of confusion because his services are narrow and distinct from IMI's services. In doing so, he has disregarded the breadth of the services identified in his trademark application, which are identical to, overlapping with, and/or closely related to IMI's services. These facts, combined with the identical trade channels and class of consumers, compels the Board to sustain the opposition.

I. Opposer Enjoys Prior Trademark Rights

There is no dispute that IMI began using its WHERE FOOD COMES FROM trademarks (both in word and design format) before Applicant's priority date. IMI has established via testimony and supporting documentation that, since at least as early as 2008, its marks have been used in connection with its services. [Saunders 30:6-21, 30:24-31:8; Saunders 70:21, Exhibit 2, Page IMI00054, Exhibit 3, IMI000089]. These documents show prior use of the mark with identical/overlapping services of Applicant.

For instance, Exhibit 2, a copy of IMI's website dated 2007-2008 contains the message:

"We believe in having a personal relationship with local farmers, ranchers, fishers, bakers, brewers, vintners, roasters, and manufacturers. To us, buying and eating home grown product is more than just a business model. It's a way of life....Our new private label, **Where Food Comes From**, will help strengthen local family farmers, encouraging more sustainable agricultural practices and provide consumer resources for fresher, better tasting food."

Before Applicant's adoption of KNOWWHEREYOURFOODCOMESFROM.COM, IMI was also offering its website information services with relevant articles in the field of food and food

sources. Exhibit 2 (Page IMI000089) is a copy of IMI's website containing a number of blurbs from third-party articles about food growing, food safety, ethical food choices, restaurants, and local/urban farms. That web page also provided links to IMI's web pages with information regarding "Producer Information," "Food Safety/Recalls," "Health and Nutrition," and "Meat and Seafood." These early-offered services fall directly within Applicant's recitation of services.

Yet, at least more than a year after that date, Applicant filed his trademark application (on December 2, 2009), which is the earliest priority date for the opposed mark on the record. And Applicant did not began using his mark in commerce until March 11, 2010. [Discovery Deposition of Frank Barrie ("Barrie"), taken June 30, 2011, 86:19-87:19; Barrie Ex. 16 (Rog. 6)]. In light of IMI's prior rights for a confusingly similar mark for related and overlapping services, the application should not proceed to registration.

II. The WHERE FOOD COMES FROM Marks Are Distinctive and Strong

Applicant argues that the parties' respective words that make up the trademarks are weak and are entitled to limited protection. While IMI's words have been disclaimed in its Principal Registration and the word mark is currently registered on the Supplemental Register, this is not evidence that the marks lack distinctiveness as of this date. Nor does it follow that there can be no likelihood of confusion created by Applicant's mark.

To argue that Applicant's and IMI's marks are weak is disingenuous in light of conflicting testimony and argument in Applicant's Trial Brief. Applicant testified that he selected and adopted the opposed mark understanding the "importance of having an attractive and distinctive 'brand identity' for his website." Applicant's Trial Brief, p. 7. Yet later in his brief, Applicant contends that

the words in both of the parties' marks are weak and, thus, no likelihood of confusion exists. These positions do not jive.

With regard to IMI's Supplemental Registration, "likelihood of confusion can be found even if a term is merely descriptive and does not identify source: Registration on the Supplemental Register is sufficient, and a showing of trade identity rights in the form of secondary meaning is unnecessary." *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1042 (Fed. Cir. 1990) (citing *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978) and *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49 (Fed. Cir. 1986). See also *Perma Ceram Enter. Inc. v. Preco Indus. Ltd.*, 23 USPQ2d 1134, 1138 n.12 (TTAB 1992). Thus, in light of IMI's registration on the Supplemental Register, it is not required to prove, in addition to prior use, that its mark was distinctive of its goods prior to Applicant's first use of its mark.

Regardless, IMI's service marks are not without distinctiveness, even if the Board were to decide the words were somewhat weak. IMI has provided significant financial data, including revenues and advertising expenditures, among other things, in its Trial Brief that support a finding of distinctiveness. And while not precedential, the Board addressed a similar issue in *H2O to Go, LLC v. Cook*, where the opposition involved the marks WATER TO GO and H2O TO GO. The Board in that case stated that "even assuming the mark is weak, it is well settled that even weak marks are entitled to protection against registration of similar marks for identical and/or closely related goods and services." 2008 WL 4674615 at *7 (TTAB)(opposition was sustained where opposed mark was confusingly similar to a mark on the Supplemental Register, citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion "is

to be avoided, as much between 'weak' marks as between 'strong' marks, or as between a 'weak' and a 'strong' mark"); and *The Clorox Co.*, 578 F.2d at 341 (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover)).

IMI's marks have been in substantially exclusive use in commerce for more than four years and, therefore, should be considered to be strong and have acquired secondary meaning. And, in any event, IMI's services marks on the Principal and Supplemental Register, at a minimum, possess distinctiveness sufficient to sustain the opposition against Applicant.

III. The Marks are Similar in Appearance, in Sound, and in Commercial Impression

Applicant's KNOWWHEREYOURFOODCOMESFROM.COM mark and IMI's WHERE FOOD COMES FROM Marks are substantially similar. Each mark conveys the same commercial impression. It would be easy for a consumer recalling either trademark to use the other's mark—especially because the services are overlapping. *See In re Copytele Inc.*, 31 U.S.P.Q.2d 1540 (TTAB 1994) (ITU application for SCREEN FAX PHONE for fax terminals properly refused on basis of Supplemental Registration of FAXPHONE for virtually identical goods).

Applicant argues that his color scheme and artwork will distinguish the marks. IMI has already disputed this in detail in its Trial Brief, and it is important to note that IMI has not claimed color in either of its registrations. Thus, IMI is properly permitted to use identical coloring to that of Applicant, i.e. "blue, white, and black."

Regardless, the TTAB has long held that words are considered more important than a design in a composite mark. "If a mark comprises both wording and a design, greater weight is often given

to the wording, because it is the wording that purchasers would use to refer to or request the goods or services.” TMEP 1207.01(c)(ii) (citing *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1247 (TTAB 2010); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987)). Here, the words WHERE FOOD COMES FROM and KNOW WHERE YOUR FOOD COMES FROM.COM are nearly identical.

The similarity in sound of the respective marks is, alone, sufficient to support a finding of likelihood of confusion. *See Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968). And the “.COM” portion of Applicant’s mark adds no distinguishing element. TMEP §§1209.03(m) and 1215.05. The difference in the words is visually insignificant, and is not likely to be noted or remembered by consumers when seeing these marks at separate times with identical or related services.

Consequently, the design element or additional generic words used with Applicant’s mark are not enough to preclude confusion. The wording in Applicant’s mark creates a commercial impression apart from the design element. The minimal differences in the marks are outweighed by the dominant similarities between the marks.

IV. Applicant Fails to Distinguish Between the Services Set Forth in the Opposed Application, Which Are Considered to Travel in All Relevant Trade Channels.

Applicant improperly spends much of his brief explaining how his current services are manifested and how his current users, trade channels, competitors, and advertising methods are different than IMI’s. For instance, he states that “[T]he most dispositive fact is that the appearance and look of the home page for the Opposer’s website, www.wherefoodcomesfrom.com, to any

reasonable person cannot be confused with the home page of the Applicant's website." Applicant's Trial Brief, p.18.

But "[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the **identification of goods set forth in the application** regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed." *Octocom Sys., Inc. v. Houston Comp. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (emphasis added); *see also Paula Payne Pds. v. Johnson Pub. Co.*, 177 USPQ at 77 ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods."). Therefore, a registration for the services identified in the application would not be limited as suggested by Applicant. Instead, Applicant's applied-for services encompass, overlap with, or are closely related to IMI's services.

Similarly, in evaluating a likelihood of confusion under the *du Pont* factors, the Board must assume that the services are sold through all the normal and usual trade channels for such services to all the usual purchasers of such services. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys. Inc.*, 918 F.2d 937. In this case, the channels of trade for these services already overlap. And because the parties' services overlap, the prospective consumers of Applicant's services would likely also be consumers or prospective consumers of IMI's services.

Even as a small start-up, Applicant is competing with IMI for some of IMI's services offered in connection with the WHERE FOOD COMES FROM Marks. And due to the comprehensive and

broad recitation of services in the application, nothing in an ensuing registration would preclude Applicant from using its mark exactly like IMI. What is more, Applicant could transfer any of his trademark rights to another of IMI's competitors, giving them generous rights that would detrimentally impact IMI.

Similarly, Applicant advocates an artificial distinction between "consumers" and "customers." Applicant's Trial Brief, pp. 8 and 12. There is no support in the record or general knowledge that this distinction is relevant here. Indeed, IMI provides services to its customers and broadly to consumers worldwide.¹ Even its 2007-2008 website specifically calls out "consumers." As explained more fully in IMI's Trial Brief, consumers are an essential part of the WHERE FOOD COMES FROM program. IMI's verification and labeling program are necessarily tied to consumer awareness and participation. Thus, there is no valid distinction here.

V. Applicant's Services in the Application are Broad and Closely Related with IMI's Services

It is well established that the goods and/or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. Rather, it is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under

¹Applicant complains that reference to "consumers" during the testimonial deposition was made only after a "leading question." Applicant's Trial Brief p.14. IMI disputes that this was a leading question, but, in any event, Applicant waived that objection. Any objection to an error or irregularity during a deposition is waived if it relates to the form of a question and it is not timely made during the deposition. TBMP §404.08(c); Fed. R. Civ. P. 32(d)(3)(B).

circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993); and *In re Int'l Tel. & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Applicant ignores that many of IMI's verification services are identical and related services to those Applicant has sought to register and is currently offering. While IMI engages in food source auditing, and Applicant admittedly does not, that is only one part of its program that is marketed under the WHERE FOOD COMES FROM Marks. IMI has explained that an integral part of its verification services also includes an information program directed at consumers through labeling with retailers, restaurants, and food producers [Saunders 28:14-21, 28:4-13], providing information to consumers on food-related topics [Saunders 31:9-32:1], providing information about producers that have sustainable agricultural practices [Saunders 32:2-6], and providing information and news on current topics related to food production, food retailers, food service establishments, and restaurants that offer verified food products. [Saunders 33:10-17]. All of these services empower consumers with access to information that promotes "health and environmental awareness within people so they can lead a clean and healthy life," "public awareness of shopping locally," "public awareness of the need for sustaining local agriculture," and "the goods and services of others by providing a website which users can link to local agriculture sources." In short, the services in the opposed application conflict directly with IMI's rights and are likely to cause consumer confusion.

VI. Applicant's Insertion and Request for Judicial Notice of Factual Information Should be Stricken

IMI requests that certain information that was introduced in Applicant's Trial Brief not be considered or that is be stricken, as it was not part of the record and does not constitute subject matter that may be considered by taking judicial notice. While the Board may take judicial notice of reference works (i.e. dictionaries) which exist in printed form² or information that is common knowledge, the subject matter raised by Applicant does not fall into either of those categories. Evidentiary material introduced at the trial phase of an opposition proceeding can be given no consideration unless it was properly made of record during the testimony period of the offering party, and is subject to an order striking the information. *See, e.g., Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to brief given no consideration); *Plus Pds. v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 (TTAB 1978) (applicant's exhibits attached to its brief cannot be considered).

In particular, Applicant referenced in Paragraph 12 of the Trial Brief:

- a trademark application of Real Time Farms, LLC: this application is not in the record.

(Notably, the application was refused registration on the basis that it conflicted with IMI's trademark registrations and has now become abandoned).

- a general knowledge of an "explosion" of local farms and foods;
- citation of materials from the USDA;
- and an alleged third-party marketing campaign.

² *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

Applicant did not take any testimony or introduce any evidence during Applicant's testimony period. This information was not produced during discovery. And the information was not introduced by IMI. To allow consideration of this evidence now would be unjust and prejudicial, as IMI has been precluded from rebutting the merits or weight of the information through discovery or the testimony period.

VII. Conclusion

A weighing of the relevant factors establishes that the marks WHERE FOOD COMES FROM and KNOWWHEREYOURFOODCOMESFROM.COM are confusingly similar in appearance, sound, and commercial impression. The services are overlapping, identical, and/or closely related. IMI's evidence is compelling proof that consumers will confusingly believe the parties are affiliated or associated, should Applicant be granted a registration. Therefore, it is respectfully submitted that the opposition should be sustained.

Dated: June 14, 2012

Respectfully Submitted,

/s/ Cheryl L. Burbach

Cheryl L. Burbach

HOVEY WILLIAMS LLP

10801 Mastin Boulevard, Suite 1000

Overland Park, KS 66210

Phone: 913-647-9050

Fax: 913-647-9057

Email: clb@hoveywilliams.com

Attorneys for Opposer

Integrated Management Information, Inc.

CERTIFICATE OF FILING

The undersigned hereby certifies that Opposer's Reply in Support of its Trial Brief was filed electronically under seal with the Trademark Trial and Appeal Board on this 14th day of June, 2012.

/s/ Cheryl L. Burbach

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer's Reply in Support of its Trial Brief has been served upon Applicant via U.S. mail, postage prepaid, on this 14th day of June, 2012 at the following address:

Frank W. Barrie
117 South Pine Avenue
Albany, New York 12208

/s/ Cheryl L. Burbach

H2O to Go, LLC v. Cook,
2008 WL 4674615 (TTAB 2008)

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2008 WL 4674615 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

H2O To Go, LLC

v.

Todd Kenton Cook

Cancellation No. 92044068

September 30, 2008

Shawn K. Look of Look Law Firm LLC for H2O TO GO, LLC

Gerard T. Gallagher of Baker & Daniels LLP for Todd Kenton Cook

Before Hohein, Holtzman and Kuhlke

Administrative Trademark Judges

Opinion by Holtzman

Administrative Trademark Judge:

Petitioner, H2O TO GO, LLC, has filed a petition to cancel a registration on the Principal Register owned by Todd Kenton Cook (respondent) for the mark H2O TO GO (in typed form) for “water treatment equipment, namely, filters, pumps, conditioners, water coolers and water softeners” in Class 11; and “retail water stores providing water and environmental treatment equipment, systems and supplies; water dispensers and coolers” in Class 35.^[FN1] The term H2O is disclaimed.

As its ground for cancellation, petitioner alleges priority and likelihood of confusion under Section 2(d) of the Trademark Act. In particular, petitioner alleges that respondent's mark, when applied to respondent's goods and services, so resembles petitioner's previously used and registered marks PURIFIED WATER TO GO and WATER TO GO as to be likely to cause confusion. Petitioner identifies these registrations as Registration No. 2720719 for the mark PURIFIED WATER TO GO and Registration No. 1949803 for the mark WATER TO GO for retail stores featuring bottled water, juices, water coolers, crocks and crock stands; franchising services, namely, offering technical assistance in the establishment of such retail stores.

Respondent has filed an answer denying the salient allegations in the petition.

The record includes the pleadings and the file of the involved registration. In addition, petitioner has submitted the testimony, with exhibits, of Ronald Quinn, petitioner's predecessor; and Joseph Ventresca, managing member of petitioner. Petitioner has also submitted notices of reliance on evidence which includes certified copies showing that the following pleaded registrations are subsisting and owned by petitioner:

Registration No. 1949803, on the Supplemental Register, for the mark **WATER TO GO** (typed form) for “retail stores featuring bottled drinking water, juices, ice, water coolers, crocks and crock stands; wholesale distributorships featuring bottled drinking water, juices, ice water coolers [sic] crocks and crock stands” in Class 42; WATER is disclaimed;^[FN2] and

Registration No. 2720719, on the Principal Register under Section 2(f), for the mark **PURIFIED WATER TO GO** (typed form) for “ice” in Class 30; “bottled drinking water, juices” in Class 32; and “retail stores featuring bottled drinking water, juices, ice, water coolers, crocks and crock stands; wholesale distributorships featuring bottled drinking water, juices, ice, water coolers, crocks and crock stands; franchising services, namely, offering technical assistance in the establishment of retail stores featuring water, ice, juice and related accessories” in Class 35.^[FN3]

*2 Respondent's record consists of the testimony, with exhibits, of Todd Kenton Cook; and several notices of reliance.

Both parties have filed briefs.

Standing

Petitioner's standing is established by its proof of ownership of subsisting Registration Nos. 1949803 and 2720719.

For purposes of our analysis on the merits of this case we will focus on the registration of petitioner which is closest to the involved registration, namely Registration No. 1949803 for the mark WATER TO GO on the Supplemental Register for “retail stores featuring bottled drinking water, juices, ice, water coolers, crocks and crock stands; wholesale distributorships featuring bottled drinking water, juices, ice water coolers [sic] crocks and crock stands” in Class 42.

Priority

In a cancellation proceeding, where both parties own registrations, petitioner must prove priority of use. See [Brewski Beer Co. v. Brewski Brothers, Inc.](#), 47 USPQ2d 1281 (TTAB 1998) and cases cited therein. In the case of a registration on the Principal Register, petitioner may rely on its registration as proof that the mark was in use as of the filing date of the underlying application. See [J. C. Hall Company v. Hallmark Cards, Inc.](#), 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965) (“The presumption of use emanating from the fact of registration relates back to the filing date of the application on which the registration is predicated”).

However, in the case of a registration on the Supplemental Register, a plaintiff is not entitled to rely on the underlying filing date as proof of priority. A registration issued on the Supplemental Register cannot be afforded any statutory presumptions under Section 7(b) of the Trademark Act and is therefore incompetent as evidence to establish priority of use. See [Aloe Creme Laboratories, Inc. v. Johnson Products Co., Inc.](#), 183 USPQ 447, 447 (TTAB 1974); and [In re Federated Department Stores Inc.](#), 3 USPQ2d 1541 (TTAB 1987) (a Supplemental Register registration is evidence of nothing more than the fact that the registration issued on the date printed thereon). On the other hand, where a Supplemental Registration is concerned, a plaintiff need not also establish distinctiveness of its mark prior to the defendant's first use. It is clear, under [Otto Roth & Co. v. Universal Foods Corp.](#), 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981), that a plaintiff relying on an unregistered mark, cannot prevail on a likelihood of confusion claim unless it shows that its term is distinctive of its goods or services, “whether inherently or through the acquisition of secondary meaning or through whatever other type of use may

have developed a trade identity.”

*3 Here, however, petitioner is not relying on an unregistered mark. Moreover, we note that the Court in [Towers v. Advent Software Inc.](#), 913 F.2d 942, 16 USPQ2d 1039, 1042 (Fed. Cir. 1990), cited an exception to the general rule set forth in *Otto Roth*. That exception involves the situation where a plaintiff alleging likelihood of confusion owns a Supplemental Register registration. The Court stated that: “[L]ikelihood of confusion can be found even if a term is merely descriptive and does not identify source: Registration on the Supplemental Register is sufficient, and a showing of trade identity rights in the form of secondary meaning is unnecessary.” *Towers*, id., citing *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978) and *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49 (Fed. Cir. 1986). See also *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1138 n.12 (TTAB 1992)

Under the circumstances, we find that petitioner is not required to prove, in addition to priority, that its mark WATER TO GO was distinctive of its services prior to respondent's first use of its mark. Moreover, we find that although petitioner's mark as a whole, while perhaps inherently weak, is not entirely without distinctiveness.

We turn then to the question of priority of use. Mr. Quinn, petitioner's predecessor, testified that the first retail store opened under the name PURIFIED WATER TO GO in Las Vegas, Nevada in 1993. Mr. Quinn introduced a yellow pages advertisement for the store dated 1996, showing the mark and the sale of such goods as crocks, coolers, water and water bottles, and also showing that there were three store locations in Las Vegas at that time, which Mr. Quinn confirmed. It can be seen from this advertisement, as well as most all of petitioner's other records of use, that the term WATER TO GO consistently appears in large, bold letters, in contrast to the word “Purified” which appears in tiny cursive writing either above or to the left of WATER TO GO. It is clear that WATER TO GO is used in a manner that creates a commercial impression separate and apart from its use in the phrase PURIFIED WATER TO GO.

Petitioner's testimony and supporting documentation are sufficient to demonstrate petitioner's prior and continuous use of the mark WATER TO GO in connection with retail stores featuring water and water-related products since at least 1996, which is prior to the August 11, 1997 filing date of respondent's underlying application and the April 1997 date of first use established by respondent.

Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Services/Trade channels/Purchasers

*4 In our evaluation of these *du Pont* factors, we are bound by the goods and services as identified in the involved registration. In the absence of any restrictions or limitations in the registration, we must assume the goods and services are sold through all the normal and usual trade channels for such goods and services to all the usual purchasers of such goods and services. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d

937, 16 USPQ2d 1783 (Fed. Cir. 1987).

Respondent's goods and services are identified as “water treatment equipment, namely, filters, pumps, conditioners, water coolers and water softeners”; and “retail water stores providing water and environmental treatment equipment, systems and supplies; water dispensers and coolers.” Petitioner operates the same type of retail stores featuring same the types of products, i.e., water, water bottles, water coolers and other water-related products. [FN4]

Thus, the parties' respective services are essentially the same.

Furthermore, petitioner's retail water stores are closely related to respondent's goods, which include water, bottled water, crocks and coolers. It is well settled that the likelihood of confusion may result from the use by different parties of the same or similar marks in connection with goods, on the one hand, and services which deal with or are related to those goods, on the other. See *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988); and *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983). Furthermore, the record shows that petitioner itself applies its WATER TO GO mark on goods such as water bottles, crocks and coolers, some of the products for which respondent's mark is registered.

Because there are no restrictions in the registration, we must presume, based on the nature of the identified goods and services, that respondent's retail stores and at least some of the products sold in the store, e.g., water, which is broad enough to encompass bottled water, and water coolers, would be directed to and purchased by ordinary consumers. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998). In fact, the evidence shows that both parties advertise and promote their products and services to the general public in the same types of print media, such as Yellow Pages directories, handouts and fliers which contain discount coupons for water fills or refills; and both parties' stores are selling products that may be purchased by ordinary consumers. For example, Mr. Cook testified that he sells countertop water filters which hook to the kitchen sink for home use. (Dep., p. 33.)

Strength of petitioner's mark

*5 Petitioner has used the mark WATER TO GO in connection with its retail water stores and water-related products for more than 10 years. Petitioner currently has 60 stores in 20 states, and Mr. Ventresca states that approximately 20 more stores are in the process of opening. Petitioner has promoted the mark primarily through print advertising such as newspapers, fliers and phone books, and through the Internet. More recently, the mark has been displayed on a water bottle-shaped hot air balloon which has been flown at large public events attended by hundreds of thousands of people. The mark is also prominently displayed on petitioner's storefronts and on its product labels and on all of its promotional materials. The evidence of record also shows that petitioner has successfully franchised its stores, having been consistently recognized by the trade publication *Entrepreneur Magazine* as one of its “Franchise 500” for all but one year since 1997.

In addition, petitioner has submitted evidence of its sales and advertising expenditures for the 21/2-year period from 2004 to the first half of 2006. Although the specific amounts are confidential, we can say they are substantial.

Petitioner has also successfully policed its mark. In particular, petitioner's predecessor received a preliminary injunction against a potential competitor's use of a similar mark. [FN5]

The evidence of record is sufficient to persuade us that petitioner's mark WATER TO GO, although perhaps initially weak, has achieved some degree of strength and recognition in the marketplace, and that it functions as a

significant indicator of source. Accordingly, we find that the mark is entitled to a broader, rather than a narrower, scope of protection.

We also note that there is no evidence of any third-party use or registration of the same or similar marks in the record or any other evidence which might tend to suggest that purchasers would be accustomed to making distinctions between the WATER TO GO mark and others based on more subtle differences in the marks.

The marks

We turn then to a comparison of respondent's mark H2O TO GO with petitioner's mark WATER TO GO, keeping in mind that when marks would appear in connection with services that are identical, the degree of similarity between the marks necessary to support a finding of likelihood of confusion declines. [Century 21 Real Estate v. Century Life](#), 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Furthermore, it is well established that, in proceedings before the Board, the question of likelihood of confusion must be decided on the basis of the mark "exactly as shown" in the registration regardless of how the mark is actually used. [Jim Beam Brands Co. v. Beamish & Crawford, Ltd.](#), 937 F.2d 729, 19 USPQ2d 1352, 1356 (2d Cir. 1991) (distinguishing infringement proceedings from Board proceedings). See also [Kimberly-Clark Corp. v. H. Douglas Enterprises](#), 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985). Consequently, respondent's arguments regarding the trade dress used in association with its mark are irrelevant. Moreover, and in any event, the wording WATER TO GO in petitioner's mark creates a commercial impression apart from any trade dress.

*6 We also point out that the standard for evaluating descriptive marks or marks on the Supplemental Register is not whether the marks are "substantially identical" as respondent claims. See [In re Southern Bell Frozen Foods, Inc.](#), 48 USPQ2d 1849 (TTAB 1998) (clarifying [In re Hunke & Jocheim](#), 185 USPQ 188 (TTAB 1975), on which respondent has relied). The same standard applies regardless of the nature of the mark or the register on which it appears. We note that the Court addressed and rejected a similar argument in [In re The Clorox Co.](#), 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978):

Appellant next posits a requirement that citation of marks on the Supplemental Register under §2(d) be limited to marks identical to that sought to be registered. No reason exists, however, for the application of different standards to registrations cited under §2(d). The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely,...but that fact does not preclude citation under §2(d) of marks on the Supplemental Register.

With the above principles in mind, when we compare respondent's mark H2O TO GO with petitioner's mark WATER TO GO, in their entireties, as used on identical retail water stores and closely related products, we find that the marks are similar in sound, appearance, meaning and in their overall commercial impression. While there are some differences between the marks, the similarities outweigh those differences.

The shared phrase TO GO is aurally and visually a significant part of both marks. While the marks begin with different words, WATER and H2O, when those words are combined with TO GO the marks as a whole are still visually similar and they have a similar sound and cadence due primarily to the two word phrase TO GO.

The marks H2O TO GO and WATER TO GO as a whole are highly similar, if not identical, in meaning and commercial impression. The term "water" is defined as "A clear, colorless, odorless, and tasteless liquid, H₂O, essential for most plant and animal life and the most widely used of all solvents." [The American Heritage Dictionary](#) (Fourth Edition) (Pet's. Third Not. of Rel., Exh. 10.) H₂O is a commonly known symbol for water, and

consumers would recognize WATER and H2O as equivalent terms. Respondent argues that merely because a dictionary mentions the chemical formula of water is not persuasive that consumers will understand that meaning. However, the dictionary does not even refer to H2O as a chemical formula, which suggests that H2O would be recognized by consumers as another term for “water.” Even Mr. Cook testified that he had to disclaim the term H2O “because it was a common everyday thing.”(Dep., p. 16.)

Viewed in their entirety, we find that the marks are similar. The high degree of similarity between the marks in terms of connotation and commercial impression significantly outweighs any dissimilarities between the marks in terms of appearance and sound.

***7** As we have found, petitioner's mark is a relatively strong one and as such is entitled to more than a narrow scope of protection. However, even assuming the mark is weak, it is well settled that even weak marks are entitled to protection against registration of similar marks for identical and/or closely related goods and services. See [King Candy Co. v. Eunice King's Kitchen, Inc.](#), 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion “is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark”); and *The Clorox Co.*, supra at 341 (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover).

Contrary to respondent's apparent contention, it is not dispositive or even relevant that the examining attorney did not cite petitioner's registered mark WATER TO GO against respondent's pending application for H2O TO GO.^[FN6] See [Miss Universe L.P. v. Community Marketing Inc.](#), 82 USPQ2d 1562 (TTAB 2007). This would defeat the purpose of the cancellation proceeding. We must base our conclusions on the entire record and arguments presented in this inter partes proceeding. Cf. [In re Nett Designs](#), 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Furthermore, as petitioner points out, it can be seen from the registration file for the involved registration that the examining attorney's search strategy was not calculated to find any marks that used the word “water” instead of “H2O.”

Actual confusion

Respondent argues that despite the fact that the marks have been in contemporaneous use for nearly 10 years there is no evidence of any actual confusion during that time. However, the parties' stores are located in different geographic regions. Apparently, petitioner's closest stores are located in Michigan, approximately 120 miles from respondent's two stores which are located in Hicksville and Antwerp, Ohio. Thus, it is unclear whether a meaningful opportunity for actual confusion has ever existed. See [Gillette Canada Inc. v. Ranir Corp.](#), 23 USPQ2d 1768 (TTAB 1992). There must be evidence showing that there has been an opportunity for instances of actual confusion to occur, and here the record is devoid of any such proof, so this factor is neutral. See, e.g., [Cunningham v. Laser Golf Corp.](#), 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

Conclusion

We find that purchasers who are familiar with petitioner's retail water stores, and its relatively strong and distinctive mark WATER TO GO would be likely to believe, upon encountering respondent's highly similar mark H2O TO GO also used on retail water stores and on products that are closely related thereto, that such services and goods originated with or are in some way associated with or sponsored by petitioner.

***8 Decision:** The petition to cancel is granted, and Registration No. 2310252 will be cancelled in due course.

FN1. Registration No. 2310252, issued January 25, 2000; Section 8 affidavit accepted.

FN2. Issued January 16, 1996; renewed.

FN3. Issued June 3, 2003.

FN4. We construe the term “water” in the phrase “providing water and environmental treatment equipment” as referring to drinking water rather than “water treatment equipment” and respondent's testimony and evidence clearly supports this view, showing that respondent in fact sells bottled and/or filtered water. See, e.g., Cook Dep., p. 21; and Exhs. 1 and 2; Int. Resp. Nos. 2, 4.

FN5. As respondent points out, this evidence is not probative of the question of likelihood of confusion. However, contrary to respondent's contention, the decision granting the preliminary injunction is admissible by notice of reliance as either a public record or as an official record of the court from which it issued (United States District Court for the District of Colorado (Civil Action No. 97-S-1966)); and moreover this evidence is probative of petitioner's efforts to police its mark.

FN6. Petitioner's objections to respondent's reliance on petitioner's pending application Serial No. 78868826 and the file for the application, as well as the file for petitioner's pleaded Registration No. 2720719 (PURIFIED WATER TO GO) are well taken. That evidence was never made of record during respondent's testimony period. This untimely evidence has not been considered.

2008 WL 4674615 (Trademark Tr. & App. Bd.)

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